

REMARKS

Applicant thanks the Examiner for the courtesy extended in granting a telephone interview held on 11 February 2008 with Applicant's attorney. The claims have been amended to place the application in condition for allowance.

I. Status of the Claims

Claims 18-23 are pending herein. Claims 18 and 21 have been amended to reference only the recitation of SEQ ID No. 19 and/or SEQ ID No. 1. Claims 24-26 have been withdrawn. A declaration has also been provided to overcome the rejection of claims 18-23 under 35 USC 112, second paragraph. Moreover, the declaration establishes the existence of enablement for claim 22 and overcomes the rejection of claim 22 under 35 USC 112, first paragraph. No new matter has been entered.

II. Claim rejections under 35 USC 112, second paragraph

The rejection of claims 18-23 under 35 USC 112 is respectfully traversed. Upon review of the record it is clear that the original sequence ID provided to the Office and the subsequent sequence ID provided to the Office on 3/7/07 are identical. However, the sequence ID provided to applicant by the Office dated 12/6/06 is inaccurate, and is responsible for the inconsistencies pointed out by the Examiner. Accordingly, it is respectfully requested that this rejection under 35 USC 112, second paragraph, be reconsidered and withdrawn.

III. Claim rejections under 35 USC 112, first paragraph

In paragraph 9 of the Office Action the Examiner has rejected claim 22 under 35 USC 112 alleging lack of enablement for "a diagnostic agent for inflammatory diseases, "neoplastic diseases", dermatosis or "blood diseases of PMN macrophages and their lineages" which comprises an antibody of claim 18, in claim 22.

The rejection of claim 22 under 35 USC 112 for lack of enablement is respectfully traversed. Applicant has attached a declaration clearly supporting the enablement of Claim 22. Moreover, Applicants refer the Examiner to the specification starting at page 24, line 25 to page 25, line 5, which recites:

- “For example, an antigen specifically present in cancerous cells may be useful as a marker for tumor diagnosis. Also, antigens abundantly present in cell groups involved in inflammation, such as neutrophils, leak out into the blood as inflammation progresses, and thus their blood concentrations may be useful as markers for diagnosis of inflammation. Furthermore, antigens which are abnormally expressed in connection with skin diseases may be used as markers for those diseases.

Thus, assay systems for the above-mentioned calcium-binding protein or fragments thereof may be used in diagnostic agents to yield useful information as an inflammatory disease marker, a neoplastic disease (especially epidermoid carcinoma of the skin, esophagus, respiratory tract, cervix, etc.) marker, a skin disease marker or a blood disease marker, for screening of patients during examinations, specifying the nature of diseases, monitoring the effects of treatment, etc. –“

Additionally, the specification starting at page 39, line 33 to page 40, line 18, discloses the expression of CAAF1, and page 40, line 9 recites:

- “Also, the differences of cancer cells and normal cells in immunoreactivities against the anti-CAAF1 antibody suggest the usefulness of the anti-CAAF1 antibody as a diagnostic agent for cancer (particularly squamous-cell carcinoma of the skin, oral cavity, esophagus, respiratory organs and cervix). In addition, the immunoreactivity of neutrophils and macrophages against anti-CAAF1 antibody further suggests additional usefulness of the anti-CAAF1 antibody as a diagnostic agent for various inflammatory diseases –“

Based on the above, it should be clear that claim 22 does not suffer lack of enablement. A person skilled in the art would find claim 22 enabling in view of the specification alone even without the support of the accompanying declaration using experiments to substantiate enablement.

Accordingly, it is respectfully requested that this rejection under 35 USC 112, first paragraph, be reconsidered and withdrawn.

IV. Rejection of claims under 35 USC 102(b)

The rejection of claims 18-19 and 22-23 under 35 USC 102(b) in view of Guignard et al. is respectfully traversed. Likewise the rejection of claims 18-20 and 22-23 under 35 USC 102(b) in view of Kelly et al. is respectfully traversed.

Applicants have amended independent Claims 18 and 21 to reference only SEQ. ID No. 1 and/or SEQ ID No. 19. Accordingly, Applicants believe that no grounds for rejection of the claims as amended under 102(b) exist. However, the following remarks address the Examiner's rejection of the claims in the event the Examiner may continue to reject the Claims as currently amended. Applicants submit there is no teaching in either reference of an antibody which is "specific to a calcium-binding protein comprising an amino acid sequence shown in SEQ ID. No. 19, or encoded by a nucleic acid sequence shown in SEQ ID NO: 1." Nowhere is there any teaching of a nucleic acid or amino acid sequence in either Guignard or Kelly nor has the Examiner made any allegation of teaching of the sequences. Both references just describe the antibodies and proteins, but nowhere is there any mention of the antibodies specific to the respective sequences. The Examiner uses Yamamura to help support the argument, and while it is not being relied on for the actual anticipation rejection, the reference itself is from 1996. Applicants point out that this application claims priority to its parent which issued as US 5,976,832 and was filed on December 6, 1995 which ultimately claims priority to JP 7-045564 and JP 7-070468 which were filed on March 6, 1995. Therefore, Applicants believe that Yamamura cannot be used as a reference under this section of the statute.

Moreover, SEQ ID No. 19 has been found both novel and nonobvious as evidenced by US Patent No. 5,976,832, which is the parent to this application. Therefore, because the sequences underlying claims 18-23 are novel and

nonobvious, Applicants submit that claims 18-23 of this application are also novel and nonobvious.

Accordingly, it is respectfully requested that these rejections under 35 USC 102(b) be reconsidered and withdrawn.

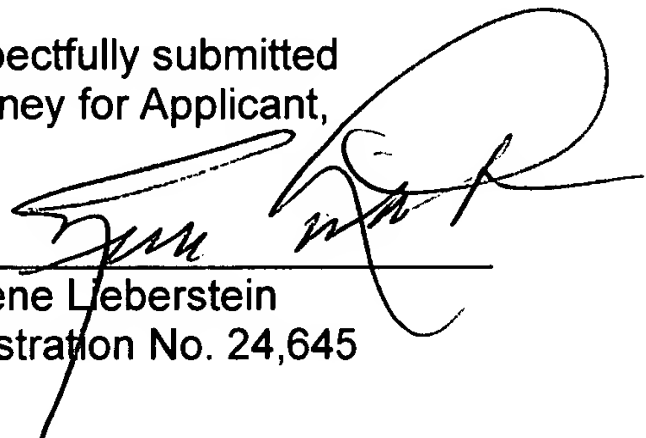
V. Rejection of claims under 35 USC 103(a)

Claim 21 was rejected under 103(a) as being unpatentable over references used to support the rejection of Claims 18-23 under 102(b). Applicant respectfully submits that there is no teaching, suggestion or motivation that would lead one of ordinary skill in the art to combine the cited references and arrive at the present invention. Accordingly, Applicant request that the rejection under 103(a) be withdrawn and the Application be forwarded to issue.

CONCLUSION

In view of the foregoing amendments to the claims and remarks, it is respectfully submitted that the present invention as defined in claims 18-23 and 25-26 is in full compliance with all the statutory requirements of Title 35 USC, and, therefore, it is earnestly requested that the Examiner's rejections be withdrawn and that the pending claims be passed to issue.

Respectfully submitted
Attorney for Applicant,

By: 
Eugene Leberstein
Registration No. 24,645


Dated: February 27, 2008

CUSTOMER NO. 01109

ANDERSON KILL & OLICK, P.C.
1251 Avenue of the Americas
New York, New York 10020-1182
(212) 278-1000

CERTIFICATE OF MAILING

I hereby certify that this *Amendment* is being deposited with the United States Postal Service via First Class Mail addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 29, 2008.


L. Felicetti